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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HENDRICKS, KEITH D

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/611,780

Applicant(s)

MARCUSSEN ET AL.

Examiner

Keith Hendricks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 33-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 33-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

i) Claims 1, 4-16 and 33-41 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicants had previously amended claim 1 to recite "a particulate component having a mean size of more than 40 μ m in the longest dimension". Prior to this amendment, the claim had previously stated that "the particles of the particulate component have a mean size of more than 40 μ m in their longest dimension." The examiner provided the current rejection, stating that these two phrases are not equivalent, and thus it is not believed that the teachings of the specification as a whole, provide support for the amended statement.

Applicant's arguments filed November 11, 2003 have been fully considered but they are not persuasive. At page 5 of the response, applicants state that they are taking the language "virtually verbatim" from the specification. This is not deemed persuasive, as this does not mean that the language is clear, and described in such a way that one skilled in the art would be enabled to make and use the invention. It is noted that the specification is a translation of a foreign priority document. Applicant further states that "the term 'particulate component' also refers to a composition that comprises more than particle." Thus it appears that applicant themselves are stating that there is more than one interpretation to the phrase, and that the "particulate component" may be either a single particle, or more than one. However, it is unclear from the specification as to where a teaching of the particulate component being a single particle, exists. Note the teachings of the specification, which refer to "the mean particle size of the particulate component", imply that the particulate component necessarily comprises more than one particle, for which there is a mean value. It is necessary that applicant clarify the claimed invention, to be supported by the teachings of the specification alone.

However unclear the specification, it is believed that the "enzyme-containing granule" produced by the claimed method comprises two parts: (1) a particulate component, and (2) an enzyme component.

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The particulate component is the *collection* of particles that are mixed with the enzyme (or enzyme/granulating agent). See the paragraph spanning pages 9-10 of the specification, as well as the statement at page 10 of the specification, which provides for the "particulate component which have a particulate distribution" [sic]. This would (a) provide a set definition for one skilled in the art, and (b) demonstrate that, indeed, the "particles" and the "particulate component" are not one and the same. Thus, as stated above and previously on the record, the phrases "a particulate component having a mean size of more than 40 μm in the longest dimension", and "the particles of the particulate component have a mean size of more than 40 μm in their longest dimension" *cannot* be equivalent.

Applicant is further referred to their own claims 33-36 and 38-41, which refer to "the particles of the particulate component" and the "particulate component" as supposedly two separate entities. Applicant is not entitled to advocate one definition in one instance, and then provide another set and definition for later use within the claims.

ii) Claims 38-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

New claims 38-41 recite a SPAN value of the particulate component. This is not supported by the specification. As stated at page 10 of the specification, "accordingly it is preferred to use a particulate component for which at least 80% w/w of the particles have a size within the range of plus or minus 40%", referring to the SPAN value of the particles which make up the particulate component. However, no desired SPAN value for the particulate component itself is provided, and in fact, referring to Figure 1 of the specification, one can see that this would not be possible, given that the particles are intermixed within the enzyme component of the granule, and thus do not provide a "particulate component" as a distinct entity for which a SPAN value could be derived. It is again noted that the specification is a translation of a foreign priority document, and does not always clearly distinguish the elements of the invention.

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Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 38-41 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 33-36. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

With regard to the phrases "particles of the particulate component" and "particulate component", at page 6 of the instant response applicant states that "applicants previously amended the claim language simply as a matter of word choice to remove redundancy". Applicant seems to be implying that these two phrases are identical and possess equivalent meaning. While the examiner does not agree with this position, if this is the case, then claims 33-36 and 38-41 must be duplicate sets of claims. Until the issue is resolved and the claims properly amended, the rejection is based upon applicant's amendment to claims 38-41, and upon applicant's conflicting arguments with regard to the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-16 and 33-41 remain rejected under 35 U.S.C. 102(b) as being anticipated by Herrman et al. (WO 97/43482). The reference and rejection are incorporated as cited in a previous Office action.

Applicants' arguments filed November 11, 2003 have been fully considered but they are not persuasive. At page 8 of the response, applicants urge "the explicit teaching of Herrman et al. as

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previously discussed, that the enzyme is added in 0.1-to 25 parts by weight enzyme or enzyme mixture calculated as dry substance content of the enzyme and the particulate component (i.e. the vehicle) is added in 75 to 99.9 parts by weight (including moisture) of the organic flour." At page 7 of the response, applicants state that "the Office's calculation of the enzyme amount fails to consider that the amounts given are for the liquid carrier containing the enzyme, not for the enzyme, and the Office has not factored in the dry substance content of the enzyme." Applicant then provides data for the amounts of dry enzyme content of the reference.

This is not deemed persuasive for the reasons of record. Initially, it is unclear how, and from what source, applicant arrived at the purported amounts of "dry enzyme" that applicant states are taught by the reference. This is not apparent from the reference. Any data provided in rebuttal must find support within the reference, along with a direct and logical connection to the teachings therein.

Regarding the percentages of enzyme mixture to particulate component of the reference, it is noted that at page 8 of the response, applicant themselves refer to the passage of page 14 of the reference, which has been addressed on the record by the examiner as providing a specific teaching which reads upon the instantly-claimed invention, and applicant follows this with "notwithstanding the above". It is unclear as to where applicant has actually rebutted the rejection, given the implied acquiescence of the phrase "notwithstanding the above", and how applicant may simply ignore specific teachings of the reference by asserting general statements about the reference. As previously provided on the record, and also quoted by applicant, from the bottom of page 14 of the reference it is stated that enzyme granulates may be prepared to contain "0.08 to 26.4 wt% (*dry substance*) enzyme or enzyme mixture, 96.92 to 43.8 wt% (*dry substance without moisture*) of a flour type" as the particulate vehicle component. This is a direct quote from the reference, and thus it is unclear as to how applicant may assert that this is not an actual quantity of the enzyme present in the granule. Furthermore, attention is drawn to page 20 of applicant's own specification, which states that "usually the enzyme will be applied to the granulation process as an enzyme containing liquid." Thus, applicants have not sufficiently differentiated the *claimed invention* from that disclosed by the reference.

At pages 8-9 of the response, applicant states that with regard to the particulate component, "the Office asserts that a mean particle size of more than 40 μm was known in the art", and that Herrman et al. does not teach or suggest using particles of this size to one of ordinary skill in the art. This is not deemed persuasive for the reasons of record. Initially, it is noted that applicants did not specifically address the facts and data presented in the previous Office action. It also appears that applicant has misinterpreted the

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rejection in that regard. As previously stated on the record, to this point, Herrman et al. specifically state at page 4 that "it is expedient in the method according to the invention to use organic flours that are obtained by grinding of cereal grains, legumes and/or fruits of the Malvaceae family (e.g. cottonseed). The cereals that can serve as flour sources within the scope of the invention are especially wheat or rye." As previously stated on the record, such flours were known to have "a mean size of more than 40 μm ". For example, as evidence to support this statement, common particle sizes of pasta wheat flours, which are even smaller than traditional wheat flours, are still in the 550-150 micrometer granulation particle size range; some having a more standardized flour with a granule range of 350-130 micrometers (*Handbook of Cereal Science and Technology*, Lorenz et al., 1991, page 16), and corn (maize) was known to be in "the commonly used particle-size range (100-1,000 μm)" (*Influence of Particle Size on the Twin-Screw Extrusion of Corn Meal*, B. W. Garber, et al., Cereal Chem. 74(5):656-661, Copyright 1997 by the American Association of Cereal Chemists, Inc.). Thus, the Office is not making an improper rejection; quite the contrary in fact, and does not utilize any combination of references. The rejection is based upon the specific teachings of the Herrman et al. reference alone, where the examiner has provided direct evidence to support the fact that the flours (i.e. the particulate component) used by Herrman et al. do indeed read upon that portion of the instantly-claimed invention.

Finally, with respect to the SPAN value of instant claims 33-36 and 38-41, applicants again state that "Herrman et al. does mention anything about the importance of the SPAN value, let alone, the importance of a SPAN value of less than 2.5." This is not deemed persuasive for the reasons of record. Initially, it is noted that not all of the present claims recite a SPAN value. Further, as previously stated, the fact that applicant has *recognized* another advantage which would inherently exist and flow naturally from the teachings of the prior art reference, cannot be the basis for patentability when the actual process steps of the claimed invention were disclosed therein. Under this statute, the reference must teach the claimed invention, which it does, and the authors need not disclose or even recognize "the *importance* of a SPAN value of less than 2.5", or any other feature of its disclosed invention. A reference need not characterize each and every feature of their disclosed invention. Furthermore, applicant may not obtain a patent for a method based solely upon the "discovery" or "recognition" of a property, which already inherently existed within the method of the reference. Applicant has provided no clear and convincing evidence and/or arguments to demonstrate that these values did not exist within the end product of the reference. However, the experiments of Herrman et al. provide for a range amount of "acceptable granules 200-1000 μm " at 63 wt%. The examiner has provided support on the record regarding the size of

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the particulate component, and thus as the claimed components used in the disclosed process, as well as the process steps themselves, meet the limitations of the instant claims, the instant invention is anticipated by Herrman et al.

Conclusion

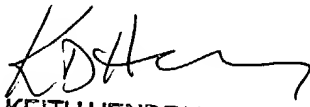
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


KEITH HENDRICKS
PRIMARY EXAMINER